

### **REMARKS**

This responds to the Office Action mailed on September 27, 2006, and the references cited therewith.

Claims 1, 19, and 27 are amended; claim 3 is cancelled without prejudice to the Applicants; as a result, claims 1-2 and 4-39 are now pending in this application.

The Applicant would like to direct the Examiner's attention to the original filed specification to page 8, line 10-23 to page 9 line 4 and lines 27-28 of page 9; page 10 lines 19-27; page 11 lines 20-27; page 12 lines 5-15 and 19-21; page 13 lines 19-28 and continuing to page 14 line 28; page 15; page 16 lines 10-28; and page 18 line 26 and continuing to page 19 line 14. These references provide ample support for each and every claim limitation made above to the independent claims.

### **§103 Rejection of the Claims**

Claims 1-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. in view of Cook and Findley. It is of course fundamental that in order to sustain an obviousness rejection that each and every step or element in the rejected claims must be taught or suggested in the proposed combination of references. Moreover, any proposed combination of references is improper if there is not a sufficient showing of motivation by one of ordinary skill in the art to combine the references.

Applicants would further like to point out that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art recited also suggests in some manner the desirability of the proposed combination. *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990). Applicants would also like to note that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002); *Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998). This requirement is rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decision making, as it is in 35 U.S.C. § 103. *See id.*, at 1344-45." *In re Kahn*, No. 04-1616 (Fed. Cir. March 22, 2006).

It has also been held that when the primary teachings of one reference is negated or taught against or taught away from another reference in the proposed combination, then it is common sense that one of ordinary skill in the art would not have been motivated to combine the references in the manner being proposed, because in so doing the very teachings that are asserted to be complimentary are by definition not complimentary to one another. Thus, there is no motivation by one of ordinary skill in the art to combine the references. It is also the case that the intended functions of the references being combined cannot be destroyed when combined. *See In re Grasselli*, 713 F.2d 731, 743; 218 USPQ 769, 779 (Fed. Cir. 1983).

The Examiner argues that the features that the Applicants have argued in the RCE response are not claimed; however, Applicants note that the exact argument does not have to be claimed the previous claimed language supported the features, which the proposed references could not support.

Yet, in an effort to expedite the prosecution, Applicants have made amendments to the independent claims to demonstrate that the “payment facilitator” as claimed cannot exist either expressly or inherently in the proposed combination of references. Specifically, there is no ability in the prior art references for the communication to the payment facilitator to occur via a web site interface and for communications from and to the payment facilitator to be via email. The Examiner at least partially acknowledges this with reference to the comments regarding the rejection of claims 18 and 39. The new claim limitations provide even more specific limitations that cannot be accounted for in the Examiner’s rationale with respect to claims 18 and 19.

Moreover, there is no concept of a single entity “payment facilitator” in the proposed combination of references where a single web site interface permits interaction with the buyer and seller and where the same payment facilitator receives email address for the buyer and seller and where the payment facilitator communicates with a buyer’s financial institution via a dedicated line and sends and receives at least some communications via email. This demonstrates Applicants prior points that the other approaches are using conventional approaches and not capable of providing the level of automation that Applicants’ invention can via the novel “payment facilitator.”

Furthermore, Applicants assert that the proposed combination is improper because there is no motivation of one skilled in the art to make such a combination. Specifically, in the Lee

reference fraud relies on being resolved at the merchant site and Lee's scoring system or fraud system is not also capable of debiting and directly interacting with financial institutions. In Cook, the authorization system is incapable of crediting accounts and cannot debit an account at a financial institution; and Cook relies on a centralized system. Both Lee and Cook rely on fraud detection at the merchant site and conventional financial processing mechanisms. In Findley, there is no discussion of crediting and debiting accounts within the specification other than what appears in the background. Also in Findley, previous purchase information is used to potentially block new purchases in another centralized approach. One reading Lee would not be inclined to combine a decentralized approach with centralized approaches presented in Cook and Findley. By combining Lee with Cook and/or Findley the very teachings of Lee are lost and it defies common sense to think one of ordinary skill in the art would have been motivated to combine Lee with any of these references if in so doing the very intent and teachings of Lee are lost. In fact, Applicants respectfully believe this would not have occurred.

Therefore, not only does the proposed combination lack all the teachings and limitations of the amended claims but Applicants assert the proposed combination is improper. Accordingly, Applicants respectfully request that the rejections of record be withdrawn and the claims be allowed.

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (513) 942-0224 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.


Respectfully submitted,

JASON MAY ET AL.


By their Representatives,

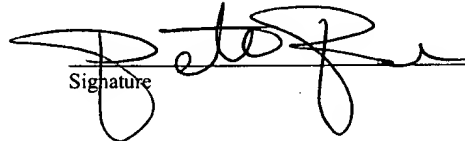
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Date January 3, 2007

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 3 day of January, 2007.

  
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